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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,978	08/31/2001	Ken Kutaragi	100809-16279 (SCEW) 18.968	7677
26304 7590 10/06/2010 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER VAN HANDEL, MICHAEL P	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/942,978	Applicant(s) KUTARAGI ET AL.	
	Examiner MICHAEL VAN HANDEL	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 15 July 2010.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8 is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-8 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/15/2010 has been entered.

Response to Amendment

2. This action is responsive to an Amendment filed 7/15/2010. Claims **1-8** are pending. Claims **1, 2, 4, 6, 7** are amended. Claims **9-12** are canceled.

Response to Arguments

3. Applicant's arguments regarding claims **1, 2, 4, 6, and 7**, filed 7/15/2010, have been fully considered, but they are not persuasive.

Regarding claims **1, 2, 4, 6, and 7**, the applicant argues that Leung et al. only provides for the content owner to enter instructions/rules based upon which the content is provided, which instructions/rules are directed to obtain a license to render the digital content and thus relies upon separate functionality. The applicant further argues that both Stefik et al. and Leung et al. would only have suggested a system that requires discrete dedicated entities - hardware or components – for obtaining and interrogating licenses for usage permission and neither would have suggested

the claimed features in connection with embedded middleware independently providing standalone functionality for utilization and usage tracking of content. The examiner first notes the rejection under 35 USC 112, first paragraph below. Applicant's specification describes middleware as giving a predetermined function to the user terminal by itself (paragraph 95 of US 2002/0035526). The examiner interprets this as the function being provided by the middleware, but the middleware does not execute the functionality completely on its own. Since the middleware is software, it requires at least a processor. Applicant's specification further states that the middleware stores and transmits the history of utilizing contents to a managing server for determining an amount of charging (see Abstract of US 2002/0035526) or that the middleware has a message call for recalling a library from the service manager (paragraph 96 of US 2002/0035526). Leung et al. discloses allowing an author to package content with instructions and/or rules that accompany the content for distribution (col. 6, l. 12-24). Leung et al. further discloses that the instructions/rules are used by the user's computing device to obtain a license to render content, and that the instructions/rules can be a script (col. 7, l. 18-27). Leung et al. discloses that the script can be written in a DRL language that can perform functions according to the script specified in the DRL (col. 27, l. 54-57 & col. 29, l. 44-50). As such, the examiner maintains that Leung et al. teaches independently providing a predetermined function to the user terminal, to said contents, said middleware including one or more programs independently providing standalone functionality, as currently claimed, in light of the interpretation based on Applicant's specification as noted in the rejection under 35 USC 112, first paragraph below.

Applicant further argues that the combination of Stefik et al. and Leung et al. fails to teach that the functionality is to autonomously monitor, and store, a contents utilizing history at

the user terminal, and transmit the stored contents utilizing history along with identification information to said information gathering means at a predetermined timing while said user terminal is connected with said network. The examiner notes; however, that this functionality is taught by Stefik et al. in the use of embedded usage rights and fees, as noted in the Office Action below. The examiner maintains that it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the embedded usage rights and fees of Stefik et al. to execute through use of a script, such as that taught by Leung et al. in order to provide a more flexible and definable enforcement architecture (Leung et al. col. 2, l. 15-19).

Applicant still further argues that the combination of Stefik et al. and Leung et al. fails to teach selectively encrypting said archive data and adding an attribute data to the encrypted archive data, the attribute data indicates one or more of a genre of corresponding content, a type of corresponding content, and a condition of transaction of corresponding content. The examiner respectfully disagrees. Stefik et al. discloses that data in the contents file may be encrypted for security (col. 9, l. 49). Stefik et al. further discloses that a distributor of digital works can add a “shell” d-block, which adds no new content beyond the content of its parts, but adds rights and fee information associated with the distribution (col. 10, l. 8-11). This information can include that the content is a story (Fig. 9), and information including under what conditions the content can be played or distributed (col. 26, l. 15-21). As such, the examiner maintains that the combination of Stefik et al. and Leung et al. teaches selectively encrypting said archive data and adding an attribute data to the encrypted archive data, the attribute data indicates one or more of a genre of corresponding content, a type of corresponding content, and a condition of transaction of corresponding content, as currently claimed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims **1-8** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims **1, 2, 4, 6, and 7**, the examiner fails to find support in Applicant's specification for middleware, which "independently provides" a predetermined function to the user terminal, to said contents, said middleware including one or more programs "independently" providing "standalone" functionality. The Abstract of Applicant's specification states that the middleware stores a history of distributing contents and transmits it to the managing server. The managing server determines an amount of charging based on the charging rule (see Abstract). Paragraph 95 of the published version of Applicant's specification states that the middleware can provide a function to the user terminal by itself, a function recalling a function of the user terminal (paragraph 95 of US 2002/0035526). For example, the middleware can have a function and parameter for recalling a library provided from the service manager (paragraph 96 of US 2002/0035526). That is, it appears that the middleware in Applicant's specification is software functions connecting different software components, like the conventional meaning of

middleware. The examiner notes; however, that the middleware is not completely “independent” or “standalone.” It requires the managing server to carry out the charging functionality and the library to carry out the services. By itself, it is only software, and requires the processor of the user terminal or another processor to execute. As such, the examiner fails to find support for the middleware independently providing standalone functionality, as currently claimed. For the purposes of expediting prosecution, the examiner interprets independently providing standalone functionality as providing an additional software function.

Claims **3**, **5**, and **8** are rejected as being dependent on the aforementioned independent claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **1** and **6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (of record) in view of Leung et al. (of record).

Referring to claims **1** and **6**, Stefik et al. discloses a method/system for managing fees of contents in which the fees arise based on a predetermined charging rule upon distributing the contents (col. 4, l. 4-10), said method/system comprising the steps of:

- equipping information gathering means on a network (Billing Clearinghouse) with which a user terminal (computer system) is allowed to connect (col. 7, l. 5-37), said

- user terminal carrying out information processing by utilizing said contents (col. 7, l. 66-67; col. 8, l. 1-18, 57-67; col. 9, l. 1-5; & Figs. 3, 4b);
- embedding usage rights and fees to said contents (col. 7, l. 7-10; col. 10, l. 8-11; & col. 11, l. 44-52), said usage rights and fees including functionality provided to said user terminal to autonomously monitor, and store, a contents utilizing history at the user terminal (metering rights provide functionality to autonomously monitor the utilization of contents, because the clock in the credit server would not monitor the time usage of contents if metered usage rights were not set)(col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col. 26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and transmit the stored contents utilizing history along with identification information (col. 31, l. 16-18, 37-41) to said information gathering means at a predetermined timing while said user terminal is connected with said network (col. 8, l. 10-20, 57-67; col. 9, l. 1-5; col. 18, l. 12-45; & Fig. 3);
 - processing a plurality of said contents, in each of which the usage rights and fees is embedded, to one archive data (composite work comprised of multiple digital works)(col. 6, l. 39-42; col. 10, l. 8-11; col. 11, l. 52-55; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);
 - selectively encrypting said archive data and adding an attribute data to the encrypted archive data (contents can be encrypted for security and a shell d-block can be added)(col. 9, l. 49; col. 10, l. 8-11; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);

- distributing said archive data and attribute data through a predetermined distribution mechanism (col. 11, l. 31-56; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);
- holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (the digital work state information and credit server keep track of how content rights have/are being used)(col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-45);
- counting a distribution condition of contents per distribution mechanism based on said contents utilizing history gathered through said information gathering means and said identification information held by said identification information holding means (Copies-in-Use field, History-list, weighted distribution fees dependent on number of copies, etc.)(col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; & Fig. 14); and
- determining a charging amount per distribution mechanism based on said counted distribution condition and a charging rule for said contents (credit server performs recording and reporting of fees associated with exercising rights)(col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col. 32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),
- wherein the contents utilizing history is stored permanently as long as the contents is utilized (keeps track of remaining time content can be used)(col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57), and the attribute data indicates one or more of a genre of corresponding content, a type of corresponding content (Figs. 8, 9), a distribution

mode of corresponding content (col. 26, l. 16-21), and a condition of transaction of corresponding content (col. 26, l. 15-21).

NOTE: The USPTO considers the applicant's "one or more of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Stefik et al. does not specifically disclose that the usage rights and fees information is middleware, which independently provides a predetermined function to the user terminal, embedded to said contents, said middleware including one or more programs independently providing standalone functionality to said user terminal to perform the usage right tasks. Leung et al. discloses allowing an author to package content with instructions and/or rules that accompany the content for distribution (col. 6, l. 12-24). Leung et al. further discloses that the instructions/rules are used by the user's computing device to obtain a license to render content, and that the instructions/rules can be a license acquisition script (col. 7, l. 18-27; col. 27, l. 54-57; & col. 29, l. 42-50). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the embedded usage rights and fees of Stefik et al. to execute through use of a license acquisition script, such as that taught by Leung et al. in order to provide a more flexible and definable enforcement architecture (Leung et al. col. 2, l. 15-19).

8. Claims **2-5**, **7**, and **8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. in view of Leung et al., and further in view of Aras et al. (of record).

Referring to claims **2**, **4**, and **7**, Stefik et al. discloses a method/system for managing fees of contents in which the fees arise based on a predetermined charging rule upon utilizing the contents (col. 4, l. 4-10), said method comprising the steps of:

- issuing a recording medium to a user operating a user terminal which carries out information processing by utilizing said contents (repository is embedded in a “card” that is inserted into an available slot in a computer system and a single device can be both a repository and a credit server)(col. 17, l. 31-36 & col. 18, l. 24-38), said recording medium having a data recording area in which user identification data is recorded (col. 13, l. 51-54, 59-67) and a memory area (col. 14, l. 28-39);
- equipping information gathering (Billing Clearinghouse) means on a network with which said user terminal with said recording medium being loaded is allowed to connect (col. 7, l. 5-37);
- embedding usage rights and fees to said contents, said usage rights and fees itself including functionality provided to said user terminal to autonomously monitor, and store to said memory area, a contents utilizing history indicating utilizing condition of the contents at the user terminal (metering rights provide functionality to autonomously monitor the utilization of contents, because the clock in the credit server would not monitor the time usage of contents if metered usage rights were not set)(col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col. 26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and read said stored contents utilizing history so as to transmit said contents utilizing history to said information gathering means along with said user identification data at a predetermined timing while said user terminal is connected with said network (col. 8, l. 10-20, 57-67; col. 9, l. 1-5; col. 18, l. 1-45; & Fig. 3);

- processing a plurality of said contents, in each of which the rights and fees is embedded, to one archive data (composite work comprised of multiple digital works)(col. 6, l. 39-42; col. 10, l. 8-11; col. 11, l. 52-55; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);
- selectively encrypting said archive data and adding an attribute data to the encrypted archive data (contents can be encrypted for security and a shell d-block can be added)(col. 9, l. 49; col. 10, l. 8-11; col. 41, l. 53-67; col. 42, l. 1-15; col. 45, l. 45-67; & Figs. 8, 9);
- distributing said archive data and attribute data through a predetermined distribution mechanism (col. 11, l. 31-56; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);
- holding, by predetermined identification information holding means, identification information for identifying said distributed contents and said distribution mechanism (the digital work state information and credit server keep track of how content rights have/are being used)(col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-45);
- counting a utilization condition of the contents per user based on the contents utilizing history and the user identification data gathered through said information gathering means (Copies-in-Use field, History-list, weighted distribution fees dependent on number of copies, etc.)(col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; & Fig. 14); and

- determining a charging amount per user based on said counted utilization condition and a charging rule for said contents (credit server performs recording and reporting of fees associated with exercising rights)(col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col. 32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),
- wherein the contents utilizing history is stored permanently as long as the contents is utilized (keeps track of remaining time content can be used)(col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57), and the attribute data indicates one or more of a genre of corresponding content, a type of corresponding content (Figs. 8, 9), a distribution mode of corresponding content (col. 26, l. 16-21), and a condition of transaction of corresponding content (col. 26, l. 15-21).

NOTE: The USPTO considers the applicant's "one or more of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Stefik et al. does not specifically disclose that the usage rights and fees information is middleware, which independently provides a predetermined function to the user terminal, embedded to said contents, said middleware including one or more programs independently providing standalone functionality to said user terminal to perform the usage right tasks. Leung et al. discloses allowing an author to package content with instructions and/or rules that accompany the content for distribution (col. 6, l. 12-24). Leung et al. further discloses that the instructions/rules are used by the user's computing device to obtain a license to render content, and that the instructions/rules can be a license acquisition script (col. 7, l. 18-27; col. 27, l. 54-57; & col. 29, l. 42-50). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the embedded usage rights and fees of Stefik et al. to

execute through use of a license acquisition script, such as that taught by Leung et al. in order to provide a more flexible and definable enforcement architecture (Leung et al. col. 2, l. 15-19).

The combination of Stefik et al. and Leung et al. does not specifically teach that the memory area of the data recording area be a nonvolatile memory area. Aras et al. discloses a method and apparatus for monitoring audio-visual materials presented to a subscriber (col. 6, l. 32-52). Monitored audio-visual information is stored in a Behavior Collection Table (BCT)(col. 9, l. 2-11). The BCT table is stored to a non-volatile memory, such as a flash memory (col. 16, l. 46-49). The collected information is then sent to a Behavior Collection Center (BCC) for processing (col. 12, l. 40-54). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the memory in the combination of Stefik et al. and Leung et al. to be a non-volatile memory, such as that taught by Aras et al. in order to retain data in a power off event (Aras et al. col. 16, l. 34-49).

Referring to claims **3** and **5**, the combination of Stefik et al., Leung et al., and Aras et al. teaches a method for managing fees of contents according to claims 2 and 4, respectively, further comprising the steps of encrypting the contents to be distributed and issuing key information for decrypting said encrypted contents, said key information being recorded in said recording medium (Stefik et al. col. 28, l. 1-37).

Referring to claim **8**, the combination of Stefik et al., Leung et al., and Aras et al. teaches a system for managing fees of contents according to claim 7, wherein said recording medium is a card equipped with an IC chip (Stefik et al. col. 14, l. 7-50 & col. 17, l. 32-36), said card being individualized per user (Stefik et al. col. 13, l. 51-67), and information indispensable for utilizing said contents is recorded in said card (Stefik et al. col. 28, l. 28-30).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Van Handel/
Primary Examiner, Art Unit 2424

10/01/2010

